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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,163	01/28/1999	HIROSHI SUMIYAMA	032567-002	6659

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BURNS DOANE SWECKER & MATHIS L L P  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/238,163

Applicant(s)

SUMIYAMA ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 12, 2002 has been entered.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 9-13, 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugiyama et al (US Patent No. 5,633,723).

Concerning claims 1, 10, Sugiyama et al discloses an image forming apparatus (Fig.1) comprising an image reader for reading an original and acquiring image data of the original (input sources which provide still and video signal to the system); a first memory (13) for storing image data; a second memory (15a) for storing image forming conditions; an image output unit (33) for printing image data stored in a first memory under the image forming conditions stored in the second memory; command means (22) for generating a command of discarding the image data to be printed from the image output unit; and a controller for discarding the image data stored in the first memory 13 when in the command of discarding the image data is generated by command means 22 while maintaining the associated image forming conditions stored in the

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second memory 15a (in the case video printer is on the video input mode); print control means (32) for causing the printer 33 to print (Figs. 1-2, 5-6; col. 3, line 42 – col. 4, line 64; col. 5, line 12-49; col. 6, line 19 – col. 7, line 32).

Concerning claims 2-6, 9, 11-13, Sugiyama et al further teaches image input unit for inputting the image data to the first memory (col. 3, lines 12-16); an output control means (32) for causing the output unit to output image data newly input from the image input unit under the maintained image forming conditions; changing means (22) for changing the maintained image forming conditions; the first memory 13 stores a plurality of image data and the output control means gives priority to the newly inputted image data to be printed under the maintained image forming conditions over the rest of the image data; the image input unit is an image reader (col. 1, lines 17-22; col. 3, lines 12-16) wherein the image output unit and the image reader operate independently; the image output unit is a printer (Figs. 1-2, 5-6; col. 3, line 42 – col. 4, line 64; col. 5, line 12-49; col. 6, line 19 – col. 7, line 32).

Claim 16 is method claim of apparatus claim 1. Claim 16 is rejected for the same rationales set forth in claim 1.

Concerning claims 17-18, McLaughlin further teaches the changing of the maintained image forming conditions; and the printing of image data of another print job on a waiting list after the newly acquired image data has completely been printed (col. 5, line 12-49; col. 6, line 19 – col. 7, line 32).

Concerning claim 19, McLaughlin discloses an image forming apparatus as discussed in claim 1 above. McLaughlin further teaches that the output control means gives priority to the

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newly inputted image data to be printed under the maintained image forming conditions over the rest of the image data.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-8, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama et al (US Patent No. 5,633,723).

Concerning claims 7-8, 14-15, Sugiyama et al does not specifically teach the case where the command means generates a command of suspending the reading operation and generates a command of discarding the image data to be printed. However, Sugiyama et al teaches the conditions of single frame print mode and multi-frame print modes for controlling the quality of image, i.e. color balance and density, and for designating the number of prints, including commands to suspend the reading operation, discarding the image data (col. 3, line 42 – col. 4, line 8; col. 5, lines 12-49; col. 7, lines 4-32). It would have been obvious to one skilled in the art to consider that the user in Sugiyama et al can use different keys of the operational panel to suspend the reading operation and discarding the image data to be printed at the same time or after the reading operation for another original has been completed as claimed in claims 7-8, 14-15 since the user can use the memory key, memory delete key, print key, conditioning key group

and character input key group to control the reading operation and the discarding of the image data to be printed according to user's desire.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Kojo (US Patent No. 5,706,412) teaches a system for selectively deleting print jobs stored in a reception buffer based on deletion data received from an external apparatus.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622

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Art Unit: 2622

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January 27, 2003